

### REMARKS

This is in response to the Office Action mailed on December 29, 2006.

Claims 6 and 17 are amended for clarification and not in response to any art. Claim 18 was added. As a result, claims 1-18 are now pending in this application.

#### §101 Rejection of the Claims

Claims 1-17 were rejected under 35 USC § 101 as being directed to non-statutory subject matter. This rejection is respectfully traversed.

The Office Action indicates that the current claims reference “possible motivation”, which is an abstract idea, and not patentable in view of *In re Wamerdam*, 33 F. 3d 1354, 31 USPQ2d 1754 (Fed. Cir. 1994). While the claims do reference “possible motivations”, it is felt that the remainder of each claim has not been considered. The claims as a whole are thought to recite subject matter that has a practical application, a useful, concrete and tangible result as indicated in *State Street Bank*, 149 F.3d 1368 (Fed. Cir. 1998). It should also be noted that several claims do not refer to possible motivations, and as such, have not been rejected with adequate specificity.

The subject matter of the application relates to using a group of people, such as experts, and providing a framework in which they can determine what someone may decide to do. That someone may be a terrorist, trying to decide what would be a good target to hit. It may be a business person trying to decide what a hacker may do to a network. Some claims describe the transformation of data related to possible motives for such people in performing actions which may cause harm. Various numbers of the claims record such motives and transform them into a model, and compare them against decision outcomes to create a list of decision outcomes. This list is a useful, concrete and tangible result that may be used to determine how to allocate resources to prevent or mitigate against attacks in an efficient manner.

In the following section, selected claims are reproduced with non-abstract portions of elements highlighted and or annotated to show in detail how the claims recite more than mere abstract ideas. The independent claims become more detailed and more tied to clearly patentable aspects, such as memories of computers as claim numbers increase. Such claims recite

patentable subject matter, and do not fall within a judicial exception. They do not recite merely abstract ideas, but also include structure and transformation of data. Comments are surrounded by double asterisks and are in *italic* font.

1. (Original) A method using a team of individual raters to generate a decision making model for predicting decisions, the method comprising:

identifying possible motivations of a decision maker; *\*\*possible motivations relate to real world things, such as economic and political unrest, ability to wage war, publicity, etc. In other words, what motivates the person making a decision. It should be noted that sensors are not required to identify the motivations. They may be easily captured by being verbalized and recorded on a computer for example. It is this representation of the possible motivations that is not abstract – note that the representations exist in the model that is created below and in further claims where they are recorded on a computer memory\*\**

entering a variety of opinions about a strength of such motivations;

weighting the motivations; *\*\*This element and the last combined provide a weight to the motivations, creating a real world model in the next element\*\**

combining the weights to create a decision making model;

identifying possible decision outcomes; *\*\*Real world outcomes are identified, such as closeness to escape routes may be measured by driving time in seconds or minutes – a transformation to a real world parameter \*\** and

assessing the possible decision outcomes with respect to the decision making model.

2. (Original) The method of claim 1 and further comprising:

generating a list of decision options *\*\* this is a real world list of possible decisions to be made by a person, such as a terrorist or hacker\*\**;

the raters rating the extent to which each of these decision options meets their opinions;

calculating a suite of statistics *\*\* a real world transformation providing quantified data for review \*\** for review by the team;

generating an ordered list of options *\*\*this list is a real world result and is useful, concrete and tangible, as the list may be used by entities such as businesses and government*

*agencies to allocate assets to protect against decisions that a terrorist or hacker may make – it is just as much a practical application as the final share price in State Street\*\* as a prediction of the most likely outcome of the decision process.*

5. (Original) A computer implemented method *\*\*a computer implemented method is a real world, non-abstract method\*\** using a team to generate a decision making model *\*\*a decision making model is a real world result that is useful, concrete and tangible, and may be used to predict decisions to allow for appropriate resource allocation to protect against decisions that a terrorist or hacker may make\*\** for predicting decisions, the method comprising:

identifying issues likely to be considered in making a decision in a decision domain;

determining relative importance of the identified issues;

identifying characteristics of issues related to making a decision; *\*\*the identification of issues, relative importance and characteristics are real world quantifications that are useful, concrete and tangible\*\**

individually rating the degree to which the characteristics are related to making the decision;

determining rankings of individuals and team identified characteristics; and

iteratively adjusting individual ratings based on the rankings to generate the decision making model. *\*\*this is a computer implemented step of processing and transforming data to create a real world, useful, concrete and tangible result – a decision making model that may be used to predict decisions to allow for appropriate resource allocation to protect against decisions that a terrorist or hacker may make\*\*.*

6. (Currently Amended) A method of predicting a decision in a decision domain by another party, the method comprising:

recruiting a team of individual raters knowledgeable about the decision domain;

the team listing decision criteria that may be considered by the another party;

listing outcome characteristics *\*\* this is a real world list of characteristics of outcomes*

*\*\*.*

the team rating the relevance of the outcome characteristics to each decision criteria\*\**a quantification of the outcome characteristics*\*\*;

assessing a covariance in ratings using a statistical analysis\*\**data is transformed*\*\*;

selecting highly rated outcome characteristics for use in a decision model\*\**a decision model is a real world practical application and not just an abstract concept*\*\*;

generating a list of decision outcomes based on highest rated outcome characteristics\*\**a list of decision outcomes is a useful, concrete and tangible result that can be displayed or otherwise used*\*\*;

each team member rating the extent to which each decision outcome addresses the outcome characteristics\*\**a further transformation of data with a real world result*\*\*;

assessing a covariation in judgments using statistical analysis to produce a weighted list of options corresponding to predictions of the decision\*\**a weighted list of options is a further transformation of data that has already been transformed at least once. The claim clearly contains several elements that are not just abstract concepts*\*\*.

14. (Original) A computer assisted method using a team to generate a decision making model \*\**a computer is involved, and a decision making model is generated – this is a useful, concrete and tangible result, as the model can be used for predicting decisions and facilitate appropriate responses, such as resource allocation to protect assets*\*\* for predicting decisions, the method comprising:

identifying issues likely to be considered in making a decision in a decision domain;

determining relative importance of the identified issues;

identifying characteristics of issues related to making a decision;

individually rating the degree to which the characteristics are related to making the decision\*\* *the previous elements clearly quantify issues to be considered in making a decision, and as such, are a practical application*\*\*;

determining rankings of individuals and team identified characteristics\*\**a further transformation of data*\*\*; and

iteratively adjusting individual ratings based on the rankings to generate the decision making model. \*\**the resulting decision making model is a useful, concrete and tangible result*\*\*

15. (Previously Presented) A physical computer readable medium *\*\*this is clearly within the section 101 categories of patentable subject matter\*\** having instructions for causing a computer to implement a method using a team of individual raters to generate a decision making model for predicting decisions, the computer implemented method comprising:

recording possible motivations of a decision maker identified by the team of individual raters *\*\*this element involves the transformation of data and recording of it\*\**;

recording a variety of opinions about a strength of such motivations; *\*\*this element involves the transformation of data and recording of it\*\**

weighting the motivations;

combining the weights to create a decision making model stored in memory accessible by the computer; *\*\*this element involves the transformation of data and recording of it in a decision making model, which is useful, concrete and tangible as previously described\*\**

recording possible decision outcomes identified by the team of individual raters; *\*\*this element involves the transformation of data and recording of it\*\** and

creating a list of the possible decision outcomes with respect to the decision making model and indication of ranking of the possible decision outcomes fixed for recording on physical media for use in determining one or more most likely decisions. *\*\*this element involves the transformation of data and recording of it in a list form.\*\**

16. (Previously Presented) A physical computer readable medium having instructions for causing a computer to implement a method using a team of individual raters to generate a decision making model for predicting a most likely target, the computer implemented method comprising:

recording possible motivations of a decision maker identified by the team of individual raters;

recording a variety of opinions about a strength of such motivations;

weighting the motivations;

combining the weights to create a decision making model stored in memory accessible by the computer;

recording possible decision outcomes identified by the team of individual raters; and  
creating a list of the possible decision outcomes with respect to the decision making  
model and indication of ranking of the possible decision outcomes fixed for recording on  
physical media for use in determining one or more most likely targets, enabling security assets to  
be efficiently utilized. *\*\*this claim is similar to claim 15 and further recites the practical  
application itself\*\**

18. (New) A computer assisted method of predicting decisions, the method comprising:  
using a team such that members on the team list decision criteria that are recorded on  
memory in the computer*\*\*data is transformed and fixed on memory – this is not an abstract  
step\*\**;

rating importance of each decision criterion by each member and recording the rating on  
memory in the computer*\*\*more transformation and storage of data\*\**;

generating a list of outcome characteristics for the decisions;

each member rating a relevance of each outcome characteristic to each decision criterion  
and recording such relevance on memory in the computer*\*\*further transformation and storage  
of data\*\**;

assessing a covariation of outcome characteristics using computer implemented statistical  
analysis*\*\*a computer further transforms data\*\**;

adjusting member ratings for outcome characteristics as a function of the statistical  
analysis*\*\*more data is transformed – not just abstract concepts\*\**;

selecting highly rated outcome characteristics;

creating and storing a decision model from such selected highly rated outcome  
characteristics*\*\*a decision model is created and stored – a computer processing and  
transforming data to create a real world, useful, concrete and tangible result – a decision  
making model that may be used to predict decisions to allow for appropriate resource allocation  
to protect against decisions that a terrorist or hacker may make\*\**;

generating a list of decision outcomes from such highest rated outcome characteristics;

each member rating an extent to which each decision outcome addresses such outcome  
characteristics and recording such rating;

assessing covariation in such ratings using computer implemented statistical analysis;  
optionally adjusting member ratings as a function of such covariation analysis; and  
generating a weighted list of predicted decisions using the computer adapted for display,  
transmission or storage\*\**processing and transforming data to create a real world, useful,  
concrete and tangible result – a weighted list that may be used to predict decisions to allow for  
appropriate resource allocation to protect against decisions that a terrorist or hacker may  
make\*\*.*

Many of the claims, particularly claims 15, 16 and 18 clearly involve computers and memories. While the application deals with abstract concepts like human decision making, these claims involve the use of a computer, recording of representations of human opinions, quantification of them, statistical analysis of them, and the creation of a models and lists that are physical entities on physical medium that is perceivable by a computer. The models and lists have utility as described above several times. They are concrete and tangible, at least because they are recorded on media, and they are not merely abstract concepts. Thus, the claims are believed to recite patentable subject matter that does not fall within one of the judicial exceptions. It is believed that a proper prima facie case of non-statutory subject matter has not been established, or is clearly rebutted by the above remarks. Reconsideration and allowance of the claims is respectfully requested.

#### §112 Rejection of the Claims

Claims 1-17 were rejected under 35 USC § 112, first paragraph, because current case law (and accordingly, the MPEP) require such a rejection if a § 101 rejection is given because when Applicant has not in fact disclosed the practical application for the invention, as a matter of law there is no way Applicant could have disclosed how to practice the undisclosed practical application. This rejection is respectfully traversed. This rejection is believed moot, as it is premised on the 101 rejection which is believed overcome.

### **Reservation of Rights**

In the interest of clarity and brevity, Applicant may not have addressed every assertion made in the Office Action. Applicant's silence regarding any such assertion does not constitute any admission or acquiescence, especially with respect to alleged implied statements regarding the state of mind of the Federal Circuit. Applicant reserves all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicant does not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner's personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, Applicant timely objects to such reliance on Official Notice, and reserves all rights to request that the Examiner provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03. Applicant reserves all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 373-6972 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

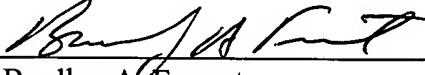
Respectfully submitted,

EDWARD L. COCHRAN

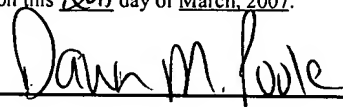
By his Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.  
P.O. Box 2938  
Minneapolis, MN 55402  
(612) 373-6972

Date 3-29-2007

By   
Bradley A. Forrest  
Reg. No. 30,837

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 29th day of March, 2007.



Name



Signature